

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of  
ERIC THELEN ET AL.

Atty. Docket  
DE 030365

Confirmation No. 1808

Serial No. 10/576,165

Group Art Unit: 2425

Filed: APRIL 19, 2006

Examiner: CHOKSHI, P.R.

Title: RECORDING CONTENT ON A RECORD MEDIUM THAT CONTAINS A  
DESIRED CONTENT DESCRIPTOR

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United States Patent and Trademark Office  
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APPEAL BRIEF

Sir:

Appellants herewith respectfully present a Brief on Appeal as follows, having filed a Notice of Appeal on September 21, 2009:

REAL PARTY IN INTEREST

The real party in interest in this appeal is the assignee of record Koninklijke Philips Electronics N.V., a corporation of The Netherlands having an office and a place of business at Groenewoudseweg 1, Eindhoven, Netherlands 5621 BA.

RELATED APPEALS AND INTERFERENCES

Appellants and the undersigned attorney are not aware of any other appeals or interferences which will directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1 and 4-22 are pending in this application where claims 2-3 are canceled. Claims 1 and 4-22 are rejected in the Final Office Action mailed in July 20, 2009. Claims 1 and 4-22 are the subject of this appeal.

STATUS OF AMENDMENTS

Appellants did not file a Response to a Final Office Action mailed July 20, 2009. Appellants are concurrently filing a Response to the Final Office Action mailed July 20, 2009 that corrects a minor informality in independent claim 21, entry of which is respectfully requested. This Appeal Brief is in response to the Final Office Action mailed July 20, 2009, that finally rejected claims 1 and 4-22.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention, for example, as recited in independent claim 1, shown in FIG 1 and described on page 10, lines 11-28, and page 11, lines 16-26 of the specification, is directed to a method for recording content 10 on a record medium 2 that contains a desired content descriptor 3, comprising the acts of reading said desired content descriptor 3 from said record medium 2; scanning the content 10 of at least one multimedia source 6, 7 for desired content that matches the desired content descriptor 3; and recording the desired content on the record medium 2. As shown in FIG 1 and described on page 10, lines 13-14, the desired content descriptor 3 is already contained in a blank of the record medium 2. As shown in FIG 1 and described on page 12, lines 11-19, inserting the record medium 2 containing the desired content descriptor 3 into a recording device 1 triggers the recording device 1 to automatically perform the acts of scanning and recording.

The present invention, for example, as recited in independent claim 19, shown in FIG 1 and described on page 10, lines 11-28,

page 11, lines 16-26, and page 10, lines 13-14 of the specification, is directed to a device 1 for recording content 10 on a record medium 2 that contains a desired content descriptor 3. The device 1 comprises means for reading the desired content descriptor 3 from the record medium 3, such as a reader 16 shown in FIG 1, and described on page 11, lines 24-26; means, such as a processor 13 and matching unit 15, for scanning the content 10 of at least one multimedia source 6, 7 for desired content that matches the desired content descriptor 3; and means, such as a user interface 18 and recorder 19, for recording the desired content on the record medium 2. As shown in FIG 1 and described on page 10, lines 13-14, the desired content descriptor 3 is already contained in a blank of said record medium 2. As shown in FIG 1 and described on page 12, lines 11-19, connecting the record medium 2 containing the desired content descriptor 3 to the device 1 triggers the scanning means, such as the matching unit 15, to automatically perform the scanning and the recording.

The present invention, for example, as recited in independent claim 21, shown in FIG 1 and described on page 10, lines 11-28, and

page 11, lines 16-26 of the specification, is directed to a record medium 2 comprising a desired content descriptor 3; and means, such as a reader 16 shown in FIG 1, and described on page 11, lines 24-26, for reading the desired content descriptor 3 from the record medium 2 to trigger scanning of content 10 of at least one multimedia source 6, 7 for desired content that matches the desired content descriptor 3 and that is recorded on the record medium 2. As shown in FIG 1 and described on page 10, lines 13-14, the desired content descriptor 3 is already contained in a blank of the record medium 2. As shown in FIG 1 and described on page 12, lines 11-19, the record medium 3 is configured to trigger a recording device 1 to automatically perform the scanning of the content and recording the desired content in response to connecting the record medium 2 to the device 1.



GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1, 5-9, 11-16, and 19-22 of U.S. Patent Application Serial No. 10/576,165 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,526,130 (Kim) in view of U.S. Patent No. 7,171,174 (Ellis-174) which is incorrectly referred to as U.S. Patent Application Publication No. 2002/0174430 (Ellis-430). U.S. Patent No. 7,171,174 (Ellis-174) is cited on Form PTO-892, Notice of References Cited, and the rejections in the Final Office Action refer to column and line numbers, where U.S. Patent Application Publication No. 2002/0174430 (Ellis-430) has NO column and line numbers, but has paragraph numbers, while U.S. Patent No. 7,171,174 (Ellis-174) does have column and line numbers.

Whether claim 4 of U.S. Patent Application Serial No. 10/576,165 are unpatentable under 35 U.S.C. §103(a) over Kim in view of Ellis-174 and U.S. Patent Application Publication No. 2002/0174430 (Ellis-430).

Whether claims 10, 17 and 18 of U.S. Patent Application Serial No. 10/576,165 are unpatentable under 35 U.S.C. §103(a) over Kim in view of Ellis-174 and U.S. Patent Application Publication No. 2006/0072354 (Ohnuma).

ARGUMENT

Claims 1, 5-9, 11-16, and 19-22 are said to be unpatentable under 35 U.S.C. §103(a) over Kim and Ellis-174.

Appellants respectfully request the Board to address the patentability of independent claims 1, 19 and 21, and further claims 4-18, 20 and 22 as depending from claims 1, 19 and 21, based on the requirements of independent claims 1, 19 and 21. This position is provided for the specific and stated purpose of simplifying the current issues on appeal. However, Appellants herein specifically reserve the right to argue and address the patentability of claims 4-18, 20 and 22 at a later date should the separately patentable subject matter of claims 4-18, 20 and 22 later become an issue. Accordingly, this limitation of the subject matter presented for appeal herein, specifically limited to discussions of the patentability of claims 1, 19 and 21 is not intended as a waiver of Appellants' right to argue the patentability of the further claims and claim elements at that later time.

As correctly noted on page 3 of the Final Office Action, Kim does not disclose or suggest "wherein inserting the record medium containing the desired content descriptor into a recording device triggers the recording device to automatically perform the acts of scanning and recording," as recited in independent claim 1, and similarly recited in independent claims 19 and 21. Ellis-174 is cited in an attempt to remedy the deficiencies in Kim.

Ellis-174 is directed to an "enhanced radio system that provides for the capture and playback of one or more radio stations," as recited in the Abstract, lines 1-2 and shown in FIG 1. The enhanced radio system has a memory 120 also shown in FIG 1. As recited on column 6, lines 65-66, a smart card that indicates user preferences is inserted into the enhanced radio, which "may automatically determine the best matching local stations." (Column 6, lines 10-11)

As specifically recited on column 16, lines 65-66:

The system may allow the user to record a portion of the radio input in memory 120 (FIG. 1) for later playback.

That is, any recording is done in the memory 120 of the radio itself, and NOT in the smart card that is inserted in the radio and

indicates the user preferences.

In stark contrast, the present invention as recited in independent claim 1, and similarly recited in independent claims 19 and 21, amongst other patentable elements recites (illustrative emphasis provided):

recording said desired content on said record medium, wherein said desired content descriptor is already contained in a blank of said record medium, wherein inserting the record medium containing the desired content descriptor into a recording device triggers the recording device to automatically perform the acts of scanning and recording.

Recording a desired content on the very same medium that includes a desired content descriptor, where the recording is automatically performed when this vary same record medium is inserted into the recording device, is nowhere disclosed or suggested in Kim, Ellis-174, and combination thereof. Rather, Ellis-174 discloses recording in the memory 120 of the radio, not in the inserted smart card that includes the user preferences.

Accordingly, it is respectfully requested that independent claims 1, 19 and 21 be allowed. In addition, it is respectfully submitted that claims 5-9, 11-16, 18-20 and 22 should also be allowed at least based on their dependence from independent claims

1, 19 and 21 as well as their individually patentable elements.

Claim 4 is said to be unpatentable under 35 U.S.C. §103(a) over Kim in view of Ellis-174 and Ellis-430.

It is respectfully submitted that claim 4 should be allowed at least based on its dependence from independent claim 1.

Claims 10, 17 and 18 are said to be unpatentable under 35 U.S.C. §103(a) over Kim in view of Ellis-174 and Ohnuma.

It is respectfully submitted that claims 10, 17 and 18 should be allowed at least based on their dependence from independent claim 1.

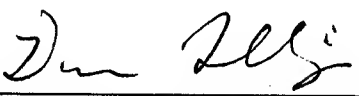
In addition, Appellants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Appellants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

CONCLUSION

Claims 1 and 4-22 are patentable over Kim, Ellis-174, Ellis-430 and Ohnuma.

Thus, the Examiner's rejections of claims 1 and 4-22 should be reversed.

Respectfully submitted,

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### CLAIMS APPENDIX

1. (Previously Presented) A method for recording content on a record medium that contains a desired content descriptor, comprising the acts of:

reading said desired content descriptor from said record medium;

scanning the content of at least one multimedia source for desired content that matches said desired content descriptor; and

recording said desired content on said record medium, wherein said desired content descriptor is already contained in a blank of said record medium, wherein inserting the record medium containing the desired content descriptor into a recording device triggers the recording device to automatically perform the acts of scanning and recording.

Claims 2-3 (Canceled)

4. (Previously Presented) The method according to claim 1,

wherein said desired content descriptor contained in said record medium cannot be further altered or augmented.

5. (Previously Presented) The method according to claim 1, wherein said desired content descriptor contained in said record medium can be further altered and augmented.

6. (Previously Presented) The method according to claim 1, wherein said desired content descriptor can be transferred from said record medium to a record medium of the same type or to a record medium of a different type.

7. (Previously Presented) The method according to claim 1, wherein said record medium is suited for electric and/or magnetic and/or optic recording of content.

8. (Previously Presented) The method according to claim 1, wherein said desired content descriptor is a keyword or a list of keywords.



9. (Previously Presented) The method according to claim 1, wherein said desired content descriptor obeys a pre-defined content description format.

10. (Previously Presented) The method according to claim 1, wherein said desired content descriptor comprises multimedia samples.

11. (Previously Presented) The method according to claim 1, wherein said desired content descriptor is a pre-defined content descriptor.

12. (Previously Presented) The method according to claim 1, wherein said desired content descriptor is defined by the user of said method.

13. (Previously Presented) The method according to claim 1, wherein said content from at least one multimedia source comprises image and/or audio and/or text information.

14. (Previously Presented) The method according to claim 1, wherein said at least one multimedia source is a receiver for television and/or radio programs.

15. (Previously Presented) The method according to claim 1, wherein said at least one multimedia source is a device that is connected to a computer network, in particular to the internet.

16. (Previously Presented) The method according to claim 13, wherein said act of scanning the content of said at least one multimedia source for said desired content comprises image and/or audio and/or word processing.

17. (Previously Presented) The method according to claim 1, wherein said act of scanning the content of said at least one multimedia source for said desired content is performed dynamically depending on the available amount of content and/or on the already recorded content.

18. (Previously Presented) A machine-readable medium embodying

a computer program, the computer program when executed by a processor is configured to perform the acts of claim 1.

19. (Previously Presented) A device for recording content on a record medium that contains a desired content descriptor, the device comprising:

means for reading said desired content descriptor from said record medium;

means for scanning the content of at least one multimedia source for desired content that matches said desired content descriptor; and

means for recording said desired content on said record medium, wherein said desired content descriptor is already contained in a blank of said record medium, wherein connecting the record medium containing the desired content descriptor to the device triggers the scanning means to automatically perform the scanning and the recording.

20. (Previously Presented) The device according to claim 19, wherein said means for scanning the content of said at least one

multimedia source for said desired content comprises means for image and/or audio and/or word processing.

21. (Previously Presented) A record medium comprising a desired content descriptor and means for reading said desired content descriptor from said record medium to trigger the scanning of content of at least one multimedia source for desired content that matches said desired content descriptor and that is recorded on said record medium, wherein said desired content descriptor is already contained in a blank of said record medium wherein the record medium is configured to trigger a recording device to automatically perform the scanning the of content and recording the desired content in response to connecting the record medium to the device.

22. (Previously Presented) The record medium of claim 21, wherein said record medium is suited for electric and/or magnetic and/or optic recording of content.

**EVIDENCE APPENDIX**

None

**RELATED PROCEEDINGS APPENDIX**

None